

ESTTA Tracking number: **ESTTA612997**

Filing date: **06/30/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
Correspondence Address	JESS M COLLEN COLLEN IP THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES ogelber@collenip.com, tgulick@collenip.com, docket@collenip.com
Submission	Other Motions/Papers
Filer's Name	Oren Gelber
Filer's e-mail	ogelber@collenip.com, tgulick@collenip.com, docket@collenip.com
Signature	/Oren Gelber/
Date	06/30/2014
Attachments	K655_Opposer's Motion for Reconsideration_140630.PDF(435065 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: ALPHA PHI OMEGA and design  
Opp. No.: 91197504 (Parent)  
Serial No.: 77950436

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: AΦΩ  
Opp. No.: 91197505 (Child)  
Serial No.: 77905236

**OPPOSER'S MOTION FOR RECONSIDERATION**

Pursuant to 37 C.F.R. § 2.127(b) and TMBP § 518, Opposer hereby respectfully requests clarification and reconsideration of the Trademark Trial and Appeal Board's Order of May 31, 2014 with regard to Applicant's Renewed Motion to Compel and Test Sufficiency of Responses.

**I. INTRODUCTION**

The Trademark Trial and Appeal Board's Order of May 31, 2014 granted Applicant's Motion to Test Sufficiency of Responses with regard to Admission Request Nos. 1, 3, 4, 7-12, 14, 16-48. See D.E. 55, pp. 5 and 7. The Board further ruled that Opposer must supplement its

response and production to Document Request No. 21 which demands production of all documents supporting denials of any of the Requests for Admission. *Id.* at pp. 5 and 6.

Opposer, in its Opposition to Applicant's Motion to Test Sufficiency and Motion to Compel, raised issues with regard to the terminology used by the Applicant. The Board's Order granted Applicant's Motion to Test Sufficiency as to Admission Request Nos. 1, 3, 4, 7-12, 14, 16-48 and overruled Opposer's objections to the subject Requests for Admission are overruled. *See Id.* at p. 6. Opposer now seeks the Board's clarification of these Requests so that Opposer may submit a proper response in compliance with the Board's Order, as the Board's Order requires Opposer to submit either an unqualified admission, denial or statement of lack of knowledge.

Opposer has served Applicant with supplemental and amended responses, supplemental document production and a privilege log. However, Opposer now, in part, seeks Reconsideration regarding Admission Request Nos. 3, 4 and 14.

## **II. ARGUMENT**

Many of Applicant's Admission Requests ask Opposer to "admit that [it] has no evidentiary basis to dispute," a certain articulated contention. Then Applicant's Document Production Request No. 21 demands production of any documents supporting any denials of any of the Admission Requests.

Applicant's "evidentiary basis" language is problematic, because Applicant appears to be insisting on an equivalent reading of its term "evidentiary basis", and the simple word "evidence". Opposer's evidentiary basis includes both the existence of certain documents and a lack of other documents.

This problematic language is exacerbated by broad and compound drafting in Admission Requests Nos. 3, 4 and 14.

**REQUEST NO. 3:** Admit that Opposer has no evidentiary basis to dispute that the word “Omega” has been continuously used in the United States as part of the name of various Greek letter social, professional, or honorary fraternities or sororities since prior to the introduction into the United States by or on behalf of Opposer or Opposer’s predecessor(s) in interest of any product bearing any of the marks upon which the Opposition is based.

**REQUEST NO. 4:** Admit that Opposer has no evidentiary basis to dispute that the Greek Alphabet letter, Ω, has been continuously used in the United States as part of the Greek letter designation of Greek letter social, professional, or honorary fraternities or sororities since prior to the introduction into the United States by or on behalf of Opposer or Opposer’s predecessor(s) in interest of any product bearing any of the marks upon which the Opposition is based.

**REQUEST NO. 14:** Admit that Opposer has no evidentiary basis to dispute that that various Greek letter social, professional, or honorary fraternities or sororities with the word “Omega” in their name have continuously marketed and/or approved others to market on their behalf products bearing insignia containing the word “Omega” or the Greek Alphabet letter, Ω, dating back prior to the introduction into the United States by or on behalf of Opposer or Opposer’s predecessor(s) in interest of any product bearing any of the marks upon which the Opposition is based.

For example, even if Opposer were to admit that fraternities or sororities have used the word “Omega,” or the Greek letter Ω, additional facts would be dependent upon this point, such as (1) whether such fraternities or sororities are social, professional or honorary in nature; (2) whether their use was in connection with a name; (3) whether their use predated Omega’s introduction of products in the U.S. market; (4) whether their use was continuous. With all these conjunctives and different subject points, it is nearly impossible to discern a proper response to these Requests, especially given the Board’s directive that an unqualified response is required.

In Request No. 3, Applicant seeks a response as to whether Opposer can challenge the fact that fraternities or sororities use the term “Omega” in their name. Is such use in conjunction

with other elements, other terms or designs? Even if there are indications that fraternities or sororities used the term "Omega" prior to Opposer's introduction of products into the U.S. in 1894, Opposer cannot say it lacks "evidentiary basis" for the proposition that such entities' use is not continuous. Opposer has an evidentiary basis, which consists of certain records, and its basis is enhanced by the wholesale absence of evidence of other records on issues such as proof of dates and continuity of use. Opposer is effectively obligated, both by Applicant's wording and the Board's requirement for an unqualified response, to serve a response which is at least in part untrue. Opposer thus seeks reconsideration as to Admission Requests Nos. 3, 4 and 14. Applicant's intent to use its undefined term "evidentiary basis" attacks Opposer's ability to rely on such a basis at trial. Because of this intended ambiguity, it is unfair to seek Opposer's unqualified admission or denial of these allegations..

### III. CONCLUSION

Opposer has attempted in good faith to comply with the Board's May 31, 2014 Order in large part, by serving upon Applicant Opposer's amended and supplemental discovery responses, supplemental document production and privilege log to Applicant. With respect to Admission Request Nos. 3, 4 and 14, Opposer respectfully asks the Board's to reconsider its Order with respect to Admission Request Nos. 3, 4 and 14. .

Respectfully Submitted,

By: Oren Gelber

Jess M. Collen  
Oren Gelber  
COLLEN IP  
THE HOLYOKE-MANHATTAN BUILDING

80 South Highland Avenue  
Ossining, NY 10562  
(914) 941-5668 Tel.  
(914) 941-6091 Fax  
*Counsel for Opposer Omega SA (Omega AG)*  
*(Omega Ltd.)*

Date: June 30, 2014  
JMC/OG

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED THROUGH THE ELECTRONIC SYSTEM FOR TRADEMARK TRIAL AND APPEALS IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

COLLEN IP

By: Oren Gelber Date: June 30, 2014  
Oren Gelber

**CERTIFICATE OF SERVICE**

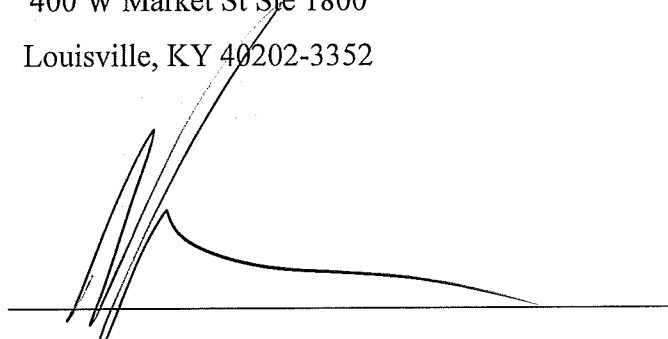
I, Peter Mulhern, hereby certifies that a copy of the foregoing **Opposer's Request for Reconsideration of Board Order** was served by First Class U.S. Mail, postage prepaid on this 30th Day of June, 2014 upon

Jack A. Wheat

Stites & Harbison PLLC

400 W Market St Ste 1800

Louisville, KY 40202-3352



Peter Mulhern